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REMARKS

Applicants note with appreciation the indication that claims 4 and 7-9 contain allowable subject matter and would be allowed if rewritten in independent form. Applicants have amended claims 4 and 7 to include the subject matter of the base claim and any intervening claims and therefore respectfully submit that these claims are in proper form to be allowed. Because claims 5-6 (as amended) and claims 8-9 are dependent on claims 4 and 7, respectively, Applicants respectfully submit that these claims are also in proper form to be allowed. Accordingly, Applicants respectfully request indication that claims 4-9 are allowed.

As set forth in the Office Action, Applicants provisionally elected without traverse Group I directed to a toneable conduit (claims 1-14, 30 and 33-34). Applicants hereby affirm that election and have cancelled non-elected claims 15-29, without prejudice. However, it is noted that claim 31 was erroneously filed as dependent on claim 28 when it should have been dependent on claim 30. Applicants have amended claim 31 to correct this error. Therefore, Applicants respectfully submit that claim 31 (and claim 32, which is dependent on claim 31), should be examined in this application and not withdrawn from consideration.

The present invention is a toneable conduit that includes an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from the channel. A continuous, high elongation wire is coincident with the channel in the elongate polymeric tube and coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube. In addition, the high elongation wire is capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled.

Claims 1 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sherlock (U.S. Patent No. 3,367,370) in view of Nakamura et al. (JP 05106779). Claims 2-3, 5-6, 10-12 and 14 also stand rejected based on the combination of Sherlock and Nakamura, and

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further in view of one or more of the Pyramid Industries advertisement ("Pyramid"), Craton (U.S. Patent No. 6,139,957), Muschiarti (U.S. Patent No. 5,227,103), Levingston (U.S. Patent No. 6,105,649), Karl (U.S. Patent No. 6,135,159), Bird (U.S. Patent No. 6,131,265) and Tzeng (U.S. Patent No. 6,005,191).

The Office Action states that Sherlock discloses a toneable conduit but acknowledges that Sherlock fails to disclose a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel, and a continuous high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled. The Office Action argues, however, that Figure 1 of Nakamura shows a channel within the wall of the polymeric tube 1 and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube 1 and located radially inward from said channel.

Sherlock discloses a plastic pipe construction having metallic material of relatively high electrical or electronic conductivity and sensitivity secured to the pipe body that allows the pipe to be located underground. See *Abstract of the Disclosure*. Nakamura discloses a buried pipe that can be detected underground. As set forth in the *Abstract* of Nakamura, a holding member 3 is installed integrally on the outer peripheral surface of an approximately tubular cover body.

PAT NO. 6,139,957
X The combination of Sherlock and Nakamura does not teach or suggest the claimed invention. In particular, as acknowledged by the Examiner, Sherlock does not disclose a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel. Nakamura also fails to provide this teaching. In particular, although it appears that Nakamura might show ribs (5) in the figures, these ribs are not located radially inward from the channel (8) as recited in the claims. Instead, these ribs are provided at other locations on the interior of the tube. Accordingly, the combination of Sherlock and Nakamura does not teach or suggest the subject matter of the present claims.

Furthermore, Figure 1 of Nakamura fails to illustrate a channel within the wall of the polymeric tube as argued in the Office Action. As shown in Figure 1, the channel (8) is not within the wall of the polymeric tube but exterior to the polymeric tube. Accordingly, Figure 1

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of Nakamura also fails to add anything to the deficiencies of Sherlock with respect to this recitation of the claims.

The other secondary references, Pyramid, Craton, Muschiatti, Levingston, Karl, Bird and Tzeng, also fail to cure the deficiencies of Sherlock and Nakamura. For example, these references fail to teach or suggest a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel. Thus, Applicants respectfully submit that claims 1-14 are patentable over the cited references and respectfully request withdrawal of the rejections related to these claims.

Claims 30 stands rejected based on the combination of Wood (U.S. Patent No. 4,109,941) in view of Sherlock, Nakamura et al. and Pelzer (U.S. Patent No. 5,212,349). Claims 33 and 34 stand rejected over these references in further combination with Tzeng and Bird, respectively.

As discussed above, the combination of Sherlock and Nakamura fails to teach or suggest the claimed invention. For example, the combination of these references fails to teach or suggest a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel as recited in claims 30, 33 and 34. Wood, Pelzer and Tzeng fail to cure the deficiencies of the teachings of Sherlock and Nakamura. Accordingly, it is respectfully submitted that claims 30, 33 and 34 (and claims 31 and 32 as amended) are patentable over the combination of Wood, Sherlock, Nakamura and Pelzer and respectfully request that the rejections based on these references be withdrawn.

Applicants respectfully submit that all the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. If any minor informalities need to be addressed, the Examiner is directed to contact the undersigned attorney by telephone to facilitate prosecution of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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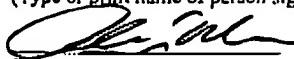
therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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CERTIFICATION OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office at Fax No. (703) 305-1341 on the date shown below. <u>Andrew T. Meunier</u> (Type or print name of person signing certification.)  Signature _____ Date <u>Jan 31, 2003</u>	CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on January 31, 2003. _____ _____ _____
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Version with Markings to Show Changes Made:

4. (Rewritten) A [The] toneable conduit [according to Claim 2, wherein],
comprising:

an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from said channel; and

a continuous, high elongation wire coincident with the channel in the elongate polymeric tube, said wire [the high elongation wire is] selected from the group consisting of copper-clad steel wire, copper-clad aluminum wire, copper wire, and tin copper wire, having an elongation of at least about 1% and coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube;

said high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled.

5. (Amended) The toneable conduit according to Claim [2] 4, wherein the high elongation wire is copper-clad steel wire.

6. (Amended) The toneable conduit according to Claim [2] 4, wherein the high elongation wire has a diameter of from about 0.32 mm to about 2.59 mm.

7. (Rewritten) A [The] toneable conduit [according to Claim 1, wherein],
comprising:

an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from said channel; and

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a continuous, high elongation wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition [is] formed of a polymeric material selected from the group consisting of fluoropolymers, polyamides, polyesters, polycarbonates, polypropylene, polyurethanes, polyacetals, polyacrylics, epoxies and silicone polymers that prevents the wire from adhering to the polymer melt used to form the polymeric tube;

said high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled.

Please cancel Claims 15-29, without prejudice.

31. (Amended) The method according to Claim [28]30, said providing steps comprising providing a first toneable conduit and a second toneable conduit wherein the high elongation wire in the first toneable conduit and in the second toneable conduit has an elongation of at least 1%.